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EXAMINER

DAILEY, THOMAS J

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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte SAJEEV MADHAVAN

Appeal 2009-010786
Application 10/635,741
Technology Center 2400

Before JOSEPH L. DIXON, ST. JOHN COURTENAY III, and
CAROLYN D. THOMAS, *Administrative Patent Judges*.

COURTENAY, *Administrative Patent Judge*.

DECISION ON APPEAL

STATEMENT OF THE CASE

This is a decision on appeal under 35 U.S.C. § 134(a) from the Examiner's final rejection of claims 1, 2, 4-16, 18-25, and 27-30. We have jurisdiction under 35 U.S.C. § 6(b).

We Affirm.

Invention

Embodiments of Appellant's invention relate generally to a method, a system, and a computer-useable storage medium for managing computing resources in a computing system. (Spec. 1). According to one disclosed embodiment, Appellant's invention is directed to:

a computing resource management method comprising: establishing a pool of free computing resources in a computing system; selecting a free computing resource from the pool of free computing resources to replace an operating computing resource in the computing system; and configuring the selected free computing resource to operate in the computing system, after replacing the operating computing resource with the free computing resource in the computing system, wherein said free computing resources comprises resources not preconfigured for use in said computing system. In alternative embodiments, the invention pertains to a computing resource management system, and a computer-useable storage media embodying aspects of the computing resource management method.

(Spec. 4).

Independent claim 1

A computing resource management method comprising:

establishing a pool of free computing resources in a computing system;

selecting a free computing resource from said pool of free computing resources to replace an operating computing resource in said computing system; and

configuring said selected free computing resource to operate in said computing system, after replacing said operating computing resource with said free computing resource in said computing system,

wherein said free computing resources comprises resources that are not preconfigured for use in said computing system according to a configuration of said operating computing resource.

REJECTION

Claims 1, 2, 4-16, 18-25 and 27-30 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over the combination of by Kaminsky (US Pat. App. Pub. 2004/0078622 A1) and Evans (US Pat. App. Pub. 2004/0039815 A1).

FINDINGS OF FACT (FF)

We adopt the Examiner's findings in the Answer. Our discussion will be limited to the points of emphasis discussed *infra*.

GROUPING OF CLAIMS

Appellant argues claims 1, 2, 4-16, 18-25 and 27-30 as a group (App. Br. 8-14). We select representative claim 1 to decide the appeal for this group. *See* 37 C.F.R. § 41.37(c)(1)(vii).

ISSUE

Based upon our review of the administrative record, we have determined that the following issue is dispositive in this appeal:

Did the Examiner err by improperly combining the Kaminsky and Evans references under § 103?

Analysis

Independent Claim 1

At the outset, we observe that the Appellant has not contested the Examiner's legal conclusion of obviousness with respect to any particular claimed limitations. Instead, Appellant contends that the Examiner has improperly combined the Kaminsky and Evans references because at least Kaminsky teaches away from the claimed invention. (App. Br. 8).

In particular, Appellant contends that

[b]y teaching that the servers have already been configured and each are hosting computing processes . . . Kaminsky teaches away from "configuring said selected free computing resource to operate in said computing system, after replacing said operating computing resource with said free computing resource in said computing system, wherein said free computing resources comprises resources that are not preconfigured for use in said computing system according to a configuration of said operating computing resource"[.] (App. Br. 10-11).

In addition, Appellant contends that the Examiner's "proposed modification would change the principle of operation of Kaminsky and would render Kaminsky unsatisfactory for its intended purpose." (App. Br. 11).

The Examiner disagrees, in pertinent part:

The appellant's contention that Kaminsky teaches away from resources not being preconfigured for use in said computing system according to a configuration of said operating computing resource is unduly limiting what the disclosure of Kaminsky would have suggested to one of ordinary skill in the art. Specifically, "An automatic server farm which has been configured in accordance with the inventive arrangements," does not directly

contradict or disparage a system in which free computing resources comprise resources that are not preconfigured for use in said computing system according to a configuration of said operating computing resource. That is, the term configured, as used in Kaminsky, need not be strictly limited to the operational configuration of computing resource, but, as is specifically recited, may simply suggest the configuration of the inventive arrangement, e.g. the physical layout. Kaminsky also teaches reconfiguration on-the-fly of the available computing resources as is ([0033], lines 1-5, an available server is assigned, and by handling the request, its computing resources must be reconfigured as they are configured to be in a state of execution), and thus it would not be beyond the means and technical grasp of one of ordinary skill in the art to configure other computing resources on-the-fly such as those in described Evans, when viewing the combination of teachings. Further still, the addition of computing resources that are not preconfigured for use in said computing system according to a configuration of said operating computing resource as disclosed in Evans would not have an adverse effect on Kaminsky's existing computing resources, as there would simply be more available resources that would be able to be configured as described in Evans above; Kaminsky's disclosed resources would be present and available all the same.

(Ans. 12-13).

Based upon our review of the record, we agree with the Examiner that Appellant's position is "unduly limiting [regarding] what the disclosure of Kaminsky would have suggested to one of ordinary skill in the art." (Ans. 12). For essentially the same reasons argued by the Examiner (Ans. 10-13), we are not persuaded by Appellant's argument that Kaminsky teaches away from the claimed invention. (App. Br. 8 *et seq.*)

"What the prior art teaches and whether it teaches toward or away

from the claimed invention ... is a determination of fact.” *Para-Ordnance Mfg., Inc. v. SGS Importers Int’l, Inc.*, 73 F.3d 1085, 1088 (Fed. Cir. 1995). “A reference may be said to teach away when a person of ordinary skill, upon reading the reference, would be discouraged from following the path set out in the reference, or would be led in a direction divergent from the path that was taken by the applicant.” *In re Gurley*, 27 F.3d 551, 553 (Fed. Cir. 1994). However, “the prior art’s mere disclosure of more than one alternative does not constitute a teaching away from any of these alternatives *because such disclosure does not criticize, discredit, or otherwise discourage the solution claimed ...*” *In re Fulton*, 391 F.3d 1195, 1201 (Fed. Cir. 2004) (emphasis added); *see also In re Dunn*, 349 F.2d 433, 438 (CCPA 1965).

Here, we agree with the Examiner that Kaminsky’s automatic server farm which has been operationally configured *does not directly contradict or disparage the claimed system* in which “free computing resources comprise resources that are not preconfigured for use in said computing system [that are then configured] according to a configuration of said operating computing resource” (claim 1). We also observe that the Examiner found these particular limitations to be taught or suggested by Evans (Ans. 5).

Moreover, Appellant has not pointed to an explicit disclosure within Kaminsky that acts to “criticize, discredit, or otherwise discourage” the aforementioned portion of the configuration clause of claim 1. *See Fulton*, 391 F.3d at 1201 (Fed. Cir. 2004). While Appellant avers that the servers of Kaminsky “have already been configured and each are hosting computing processes” and thus teach away from the claimed invention (App. Br. 10, last paragraph), we find Kaminsky expressly teaches that “[r]esources may

also be provisioned according to hybrid combinations . . . *as would be evident to one ordinary skill in the art.*” (para. [0032])(emphasis added). As pointed out by the Examiner (Ans. 12), Kaminsky teaches reconfiguration on-the-fly of computing resources in accordance with a “dynamic provisioning process” described in paragraph [0033].

Nor are we persuaded by Appellant’s arguments that the Examiner’s “proposed modification would change the principle of operation of Kaminsky and would render Kaminsky unsatisfactory for its intended purpose.” (App. Br. 11). We agree with and adopt the Examiner’s reasoning as stated on pages 13-14 of the Answer.

The Supreme Court has provided clear guidance that “when a patent ‘simply arranges old elements with each performing the same function it had been known to perform’ and yields no more than one would expect from such an arrangement, the combination is obvious.” *KSR Int’l Co. v. Teleflex, Inc.*, 550 U.S. 398, 417 (2007) (quoting *Sakraida v. Ag Pro, Inc.*, 425 U.S. 273, 282 (1976)).

This reasoning is applicable here. Given the breadth of Appellant’s representative claim 1, we are not persuaded that combining the respective familiar elements of the cited references in the manner proffered by the Examiner would have been “uniquely challenging or difficult for one of ordinary skill in the art” (see *Leapfrog Enters., Inc. v. Fisher-Price, Inc.*, 485 F.3d 1157, 1162 (Fed. Cir. 2007) (citing *KSR*, 550 U.S. at 418)).

Therefore, we find Appellant’s arguments unpersuasive that Kaminsky teaches away from the claimed invention or that the proposed modification would have changed the principle operation of Kaminsky so as to render Kaminsky unsatisfactory for its intended purpose.

On this record, we find the Examiner's proffered combination of Kaminsky and Evans references is supported by articulated reasoning with sufficient rational underpinning that reasonably justifies the Examiner's ultimate legal conclusion of obviousness. *See* Ans. 5 and 10-13.

For essentially the same reasons argued by the Examiner, as discussed above, we find Appellant has not met the burden of showing reversible error in the Examiner's prima facie case of obviousness for representative claim 1.¹ Therefore, we sustain the §103 rejection of claim 1, and claims 2, 4-16, 18-25 and 27-30 (not argued separately) which fall therewith. *See* 37 C.F.R. §41.37(c)(1)(vii).

CONCLUSION

The Examiner did not err in combining the Kaminsky and Evans references under § 103.

¹ *See In re Jung*, 637 F.3d 1356, 1365 (Fed. Cir. 2011) (“Jung argues that the Board gave improper deference to the examiner's rejection by requiring Jung to ‘identif[y] a reversible error’ by the examiner, which improperly shifted the burden of proving patentability onto Jung. *Decision* at 11. This is a hollow argument, because, as discussed above, the examiner established a prima facie case of anticipation and the burden was properly shifted to Jung to rebut it. . . . ‘[R]eversible error’ means that the applicant must identify to the Board what the examiner did wrong . . .”).

DECISION

We affirm the Examiner's decision rejecting claims 1, 2, 4-16, 18-25 and 27-30 under §103.

No time period for taking any subsequent action in connection with this appeal may be extended under 37 C.F.R. § 1.136(a).

ORDER

AFFIRMED

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